

REMARKS

Claims 33, 35, and 37-44 are pending, with claims 33 and 35 being independent. No changes to the application have been made in this paper.

Claim Rejections Under 35 USC 102

Claims 33, 35, and 37-44 have been rejected under 35 USC 102(e) as being anticipated by Yahata et al. (Yahata) (U.S. Patent Application Publication No. 2006/0236218). This rejection is respectfully traversed.

Pursuant to MPEP 706.02(f)(1)(II), Example 5 (see the marked-up copy of MPEP page 700-34 attached hereto), it is submitted that Yahata is not available as a reference against the claims of the present application under 35 USC 102(e) because it is based on the national stage of International Application No. PCT/JP04/09515 filed on June 29, 2004, which was filed on or after November 29, 2000, and was not published in English under PCT Article 21(2), even though International Application No. PCT/JP04/09515 claims the priority of U.S. Provisional Application No. 60/483,228 filed on June 30, 2003, which is before both the U.S. filing date of April 13, 2004, of the present application and the Korean filing date of August 16, 2003, of Korean Patent Application No. 2003-56725, the earliest Korean priority application of the present application. Note the following statement on the attached marked-up copy of MPEP 700-34 (emphasis added):

If the IA properly claimed the benefit of to [*sic*] any earlier-filed U.S. application (whether provisional or nonprovisional), there would still be no 35 U.S.C. 102(e) date for all the references.

WO 2005/002219 is the publication of International Application No. PCT/JP04/09515. A copy of WO 2005/002219 was attached to the Request for Reconsideration of July 23, 2009, and is in the image file wrapper of the present application. As can be seen from the copy of WO 2005/002219, this reference was not published in English.

The above arguments were also presented on pages 5 and 6 of the Request for Reconsideration of July 23, 2009. In response to these arguments, the Office states as follows on page 8 of the Office Action of November 27, 2009:

Applicant asserts that Yahata (US 2006/0236218) supra is not available as a reference against the claims of the present application under 35 USC 102(e). Examiner respectfully disagrees.

Examiner notes that the claims of the present application are rejected based on the priority date of a U.S. Patent Application Publication, not based on the priority date of a foreign application publication. Yahata is available as a 35 USC 102(e) reference because it is a published U.S. Patent Application, by others, having an effective filing date (June 30, 2003) prior to the effective filing date of the instant application (August 16, 2003). Whether or not the applicants of the Yahata U.S. Patent Application later filed an International Application claiming priority of the same U.S. provisional application has no bearing on the effective filing date of the U.S. Patent Application.

However, the applicants of the Yahata U.S. Patent Application Publication did not file a later international application claiming the priority of the same provisional application as alleged by the Office. The Yahata U.S. Patent Application Publication is a publication of the U.S. national stage of the international application, i.e., Application No. 10/561,314. There is no separate non-national stage U.S. application not based on the international application as apparently misunderstood by the Office. The applicants filed the international application on June 29, 2004, and later entered the U.S. national stage on December 19, 2005, by fulfilling the requirements of 35 USC 371(c)(1), (2), and (4) on that date as can be seen from the image file wrapper of the Yahata U.S. national stage application, i.e., Application No. 10/561,314. The filing of an international application is treated as the filing of a U.S. national application except with respect to 35 USC 102(e) pursuant to 35 USC 363, which states as follows (emphasis added):

An international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in section 102(e) of this title.

Title 35 USC 102(e) reads as follows (emphasis by underlining and material in brackets added):

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the

United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection [i.e., 35 USC 102(e)] of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Since the international application that resulted in the Yahata U.S. Patent Publication was not published in English as discussed above, 35 USC 102(e) does not apply to the Yahata U.S. Patent Publication, i.e., the Yahata U.S. Patent Publication has no 102(e) date, even though the international application claimed the benefit of U.S. Provisional Application No. 60/483,228 filed on June 30, 2003:. See MPEP 706.02(f)(1)(I)(C)(2), which states as follows on MPEP page 700-30 (emphasis by bold in original; emphasis by underlining and material in brackets added):

(2) If the international application was filed on or after November 29, 2000, but did not designate the United States or was not published in English under PCT Article 21(2), do **not** treat the international filing date as a U.S. filing date for prior art purposes. In this situation, do not apply the reference [i.e., the Yahata U.S. Patent Application Publication No. 2006/0236218] as of its international filing date, its date of completion of the 35 U.S.C. 371(c)(1), (2) and (4) requirements, or any earlier filing date to which such an international application claims benefit or priority [i.e., the filing date of June 30, 2003, of U.S. Provisional Application No. 60/483,228]. The reference may be applied under 35 U.S.C. 102(a) or (b) as of its publication date, or 35 U.S.C. 102(e) as of any later U.S. filing date of an application that properly claimed the benefit of the international application (if applicable).

As discussed above, a marked up copy of MPEP page 700-34 is attached hereto. The marked-up copy shows Example 5, which corresponds exactly to the present situation. The actual dates that are applicable to the present situation have been marked on the attached marked-up copy to assist the Office in understanding why the Yahata U.S. Patent Application Publication No. 2006/0236218 does not have a 102(e) date and thus cannot be used to reject claims 33, 35, and 37-44 under 35 USC 102(e).

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 33, 35, and 37-44 under 35 USC 102(e) as being anticipated by Yahata be withdrawn.

Conclusion

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Office is requested to telephone the undersigned to attend to these matters.

Respectfully submitted,

Date: February 25, 2010

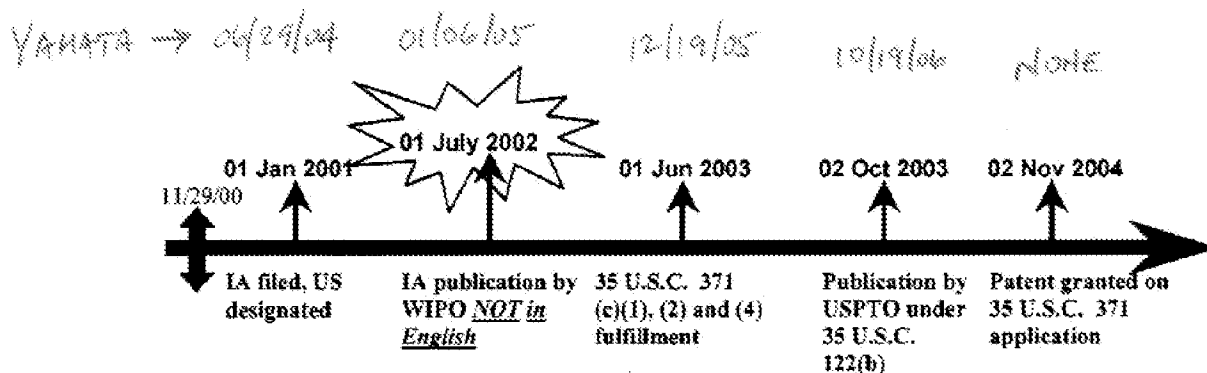
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Attachments

Example 5: References based on the **national stage (35 U.S.C. 371)** of an **International Application filed on or after November 29, 2000** and which was **not published in English** under PCT Article 21(2).

All references, whether the WIPO publication, the U.S. patent application publication or the U.S. patent, of an international application (IA) that was filed on or after November 29, 2000 but was **not published in English** under PCT Article 21(2) have no 35 U.S.C. 102(e) prior art date at all. According to 35 U.S.C. 102(e), no benefit of the international filing date (nor any U.S. filing dates prior to the IA) is given for 35 U.S.C. 102(e) prior art purposes if the IA was published under PCT Article 21(2) in a language other than English, regardless of whether the international application entered the national stage. Such references may be applied under 35 U.S.C. 102(a) or (b) as of their publication dates, but never under 35 U.S.C. 102(e).



The 35 U.S.C. 102(e)(1) date for the IA Publication by WIPO is: None.

The 35 U.S.C. 102(e)(1) date for the Publication by USPTO is: None.

The 35 U.S.C. 102(e)(2) date for the Patent is: None.

The IA publication by WIPO can be applied under 35 U.S.C. 102(a) or (b) as of its publication date (01 July 2002).

Additional *Benefit Claims:

YAHATA → 60/433,228 Filed 06/30/03

If the IA properly claimed ***>**the benefit of **<**any earlier-filed U.S. application (whether provisional or non-provisional), there would still be no 35 U.S.C. 102(e) date for all the references.

If a later-filed U.S. nonprovisional (35 U.S.C. 111(a)) application claimed the benefit of the IA in the example above, the 35 U.S.C. 102(e) date of the patent or publication of the later-filed U.S. application would be the actual filing date of the later-filed U.S. application.